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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/726,564	12/01/2000	Yoshiya Nonaka	P107156-00031	1817
4372 7590 02/06/2008 ARENT FOX LLP 1050 CONNECTICUT AVENUE, N.W. SUITE 400 WASHINGTON, DC 20036			EXAMINER TRAN, ELLEN C	
			ART UNIT 2134	PAPER NUMBER
			NOTIFICATION DATE 02/06/2008	DELIVERY MODE ELECTRONIC

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

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## Office Action Summary

Application No.

09/726,564

Applicant(s)

NONAKA ET AL.

Examiner

Ellen C. Tran

Art Unit

2134

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 19 November 2007.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-6 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-6 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

Ellen Tran  
ELLEN TRAN  
PATENT EXAMINER  
ART 2134

### Attachment(s)

- ☐ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☐ Information Disclosure Statement(s) (PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_
- ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_
- ☐ Notice of Informal Patent Application
- ☐ Other: \_\_\_\_\_

### ***Detailed Action***

1. This action is responsive to communication filed on: 19 November 2007 with acknowledgement of an original application filed on 1 December 2000 with recognition of a foreign priority date of 8 December 1999.
2. Claims 1-6 are currently pending in this application. Claims 1, 3, and 5 are independent claims. Claims 1, 3, and 5 have been amended, amendment to the claims is accepted.

### ***Response to Arguments***

4. Applicant's arguments filed 19 November 2007 have been fully considered however they are not persuasive or moot due to new grounds of rejection below.

I) In response to applicant's arguments on page 6 directed to the 112 rejection. The rejection is removed due to amendment.

II) In response to applicant's argument beginning on page 6, *"The Applicants traverse the rejection and respectfully submit that claims 1-6 recite subject matter that is neither disclosed nor suggested by the combination of Newell and Downs ... As such, Newell is directed to preventing unlawful copying of recorded information, but does not disclose or suggest preparing a backup copy for a user's legally obtained information data to make it possible to reproduce accidentally destroyed information data"*.

The Examiner disagrees with the argument Newell teaches in col. 4, lines 40-43 "Alternatively the host computer 28 may be programmed, for instance, to allow for a single duplication identity ID<sub>y</sub> without disabling corresponding storage SM<sub>y</sub> or drives DR<sub>y</sub>, so that archival copying or home copying is not prevented". The Examiner notes archival or home copying is equivalent to a backup therefore Newell teaches preparing a backup.

III) In response to applicant's argument beginning on page 9, *"The Applicants respectfully submit that Downs fails to cure the deficiencies in Newell, as Downs also does not disclose or suggest at least the feature of preventing unlawful copying, specifically, second encrypted information data recored in the second recording medium being different from the first encrypted information data recorded in the first recording medium, as recited in claims 1, 3, and 5. Down also does not disclose or suggest at least the feature of preparing a backup copy, specifically, restoring the second encrypted information data into the first encrypted information data and recording the information data in the first recording medium as recited in claims 1, 3, and 5"*.

The Examiner disagrees with argument for multiple reasons. One the references need to be reviewed in combination, Downs and Newell teaches the process of transferring protected data in SC, archival or home copying, which is equivalent to restoring data. Second as shown above Newell teaches preparing a backup. In addition Newell teaches that the encrypted copies are encrypted differently according to the storage medium, see col. 3, lines 43-59, "The information stored on SM<sub>2</sub> may be very similar to that stored on SM<sub>1</sub>, except that SM<sub>2</sub> has different identity that SM<sub>1</sub> and the information stored on SM<sub>2</sub> is encrypted with a different code than that stored on SM<sub>1</sub>, D<sub>2</sub> is programmed with a key which unlocks the encryption code of SM<sub>2</sub>. In practive, a great number (n) of mated pairs of storage media and drives represented in FIG. 1 as DR<sub>n</sub> 38 and SM<sub>n</sub> 40 may exist in communication with host computer 28 via transceiver TR<sub>n</sub> 42, and the location of various mated SM<sub>n</sub> and DR<sub>n</sub> and attached transceivers TR<sub>n</sub>".

*Claim Rejections - 35 USC § 103*

7. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

8. **Claims 1-6**, are rejected under 35 U.S.C. 103(a) as being unpatentable over Newell U.S. Patent No. 5,651,064 (hereinafter '064) in view of Downs et al. U.S. Patent No. 6,574,609 (hereinafter '609).

**As to independent claim 1, "A method for recording and reading information data using a first recording medium and a second recording medium each having its own identification data, said method comprising the steps of:"** is taught in '064 col. 2, lines 5-17;

**"reading first encrypted information data encrypted in accordance with an identification data of the first recording medium and recorded in said first recording medium"** is shown in '064 col. 3, lines 5-12;

**"encrypting the first encrypted information data in accordance with an identification data of the second recording medium, wherein the identification data of the second recording medium is different from the identification data of the first recording medium so as to produce second encrypted information data; recording the second encrypted information data in the second recording medium; reading the second encrypted information data from the second recording medium and decoding the second encrypted**

**information data in accordance with the identification data of the second recording medium”** is disclosed in ‘064 col. 3, lines 43-50;

the following is not explicitly taught in ‘064: **“restoring the second encrypted information data into the first encrypted information data and recording the information data in the first recording medium, whereby the second encrypted information data recorded in the second recording medium is different from the first encrypted information data recorded in the first recording medium”** however ‘609 teaches multiple copies can be distributed utilizing Secure Containers in col. 11, lines 54 through col. 12, lines 10.

It would have been obvious to one of ordinary skill in the art at the time of the invention a system of preventing piracy of recorded media taught in ‘064 to include a means to copy encrypted information from a recordable media into another recordable media. One of ordinary skill in the art would have been motivated to perform such a modification to encourage digital content distributors to embrace digital content distribution see ‘609 (col. 3, lines 17 et seq.) “Another reason owners of digital content have been slow to embrace electronic distribution is their desire to maintain and foster existing channels of distribution. Most content owners sell through retailers. In the music market these U.S. retailers include Tower Records, Peaches, Blockbuster, Circuit City and others. Many of these retailers have Web sites that allow Internet users to makes selections over the Internet and have selections mailed to the end-user. Example music Web sites include @tower, Music Boulevard and Columbia House. The use of electronic distribution can remove the ability of the retail stores from differentiating themselves from each other and differentiate themselves from the content owners, especially on the Web. Therefore a need exists to provide retailers of electronic content such as pictures, games, music, programs

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and videos a way to differentiate themselves from each other and the content owners when selling music through electronic distribution”.

**As to dependent claim 2, “wherein mutual confirmation is performed between the first recording medium and the second recording medium to confirm whether these recording mediums are formally registered, an encrypted information data is read out from the first recording medium or the second recording medium if the mutual confirmation shows that the first and second recording mediums are formally registered”** is taught in ‘064 col. 3, lines 65-67 (“confirmation” same as “polling”).

**As to independent claim 3**, this claim is directed to a system executing the method of claim 1; therefore it is rejected along similar rationale. Note the identification code utilized with a matching encryption key is taught in ‘064 col. 3, lines 43-50. The ability to transfer protected copy from one encrypted media to another media where the data is also encrypted is taught in ‘609.

**As to independent claim 5**, this claim is directed to a system executing the method of claim 1; therefore it is rejected along similar rationale. Note the identification code utilized with a matching encryption key is taught in ‘064 col. 3, lines 43-50. The ability to transfer protected copy from one encrypted media to another is taught in ‘609.

**As to dependent claims 4 and 6**, these claims are substantially similar to claim 2 and they are rejected along the same rationale.

***Conclusion***

THIS ACTION IS MADE FINAL. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

9. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Ellen C Tran whose telephone number is (571) 272-3842. The examiner can normally be reached from 7:30 am to 4:00 pm. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Kambiz Zand can be reached on (571) 272-3811. The fax phone number for the organization where this application or proceeding is assigned is (571) 273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR



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system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Ellen Tran  
Patent Examiner  
Technology Center 2134  
18 January 2008